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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,919	08/02/2001	Kaijun Tan	230074-0238	7139
26694	7590	08/29/2006	EXAMINER	
VENABLE LLP			HOSSAIN, TANIM M	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	
			2145	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/920,919	TAN, ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tanim Hossain	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/30/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vishwanath (U.S. 2005/0149759) in view of Naim (U.S. 6,779,115).

As per claim 1, Vishwanath teaches a method for distributing data over a network comprising: issuing a certificate and a private key to a client for identifying the client in a transaction (paragraph 0702); storing the certificate and the private key in a portable token of the client and used by the client during a transaction, the portable token being a physical device removeably coupleable to a client computer (0702, figure 13; where the card is removeably coupleable); verifying a digital signature using the certificate stored in the token before distributing data to the client (0702, 0515); and distributing the data to the client (Abstract). Vishwanath does not specifically teach the generation of a message associated with the data being downloaded. Naim teaches the generation and sending of a message associated with the data being downloaded to the client and associated with at least part of a distinguishing number for the token used by the client during a transaction (column 10, lines 44-49; where the key to be decrypted is associated with the file, and because it is decrypted only by the token, it is

associated with a distinguishing number of the token). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the generation of a message with token data into the distribution of content, as taught by Naim in the system of Vishwanath. The motivation for doing so lies in the fact that having a message with the token data would allow for better identification of the content to judge whether the correct content is being transmitted, or provide a receipt for the downloaded information, for example. Both inventions are also from the same field of endeavor, namely the safe and secure transmission of media content through a network.

As per claim 2, Vishwanath-Naim teaches the method of claim 1, further comprising providing the client with information necessary for establishing an account (Naim: column 8, lines 33-56).

As per claim 3, Vishwanath-Naim teaches the method of claim 2, further comprising providing the client with the token (Vishwanath: 0702).

As per claim 4, Vishwanath-Naim teaches a method for distributing data over a network comprising: establishing a secure connection between a client and a server (Vishwanath: 0702); issuing a certificate and a private key to the client for identifying the client in a transaction (Vishwanath: 0702); storing the certificate and the private key in a portable token of the client and used by the client during a transaction, the portable token being in a physical device removeably coupleable to a client computer (Naim: abstract, column 10, lines 44-49); and generating a message associated with the data being distributed to the client and associated with at least part of a distinguishing number for the token used by the client during a transaction (Naim: column 10, lines 44-49).

As per claim 5, Vishwanath-Naim teaches the method of claim 4, further comprising distributing data to the client (Naim: column 10, lines 44-49).

As per claim 6, Vishwanath-Naim teaches the method of claim 5, further comprising requesting information from the client for establishing an account (Naim: column 8, lines 33-56).

As per claim 7, Vishwanath-Naim teaches the method of claim 4, wherein establishing a secure connection comprises establishing a secure connection using a security protocol (Naim: column 8, lines 33-56).

As per claim 8, Vishwanath-Naim teaches the method of claim 7, wherein the security protocol is the secure socket layer protocol (Naim: column 8, lines 33-56).

As per claim 9, Vishwanath-Naim teaches the method of claim 6, wherein the requesting information comprises requesting a credit card number (Naim: column 8, lines 33-56).

As per claim 10, Vishwanath-Naim teaches the method of claim 6, wherein requesting information comprises requesting a password (Naim: column 8, lines 33-56).

As per claim 11, Vishwanath-Naim teaches the method of claim 4, wherein storing the certificate comprises: interfacing the token to a client computer (Naim: column 8, lines 33-56); and writing the certificate and the private key to the token across the network (Naim: page 2, paragraph 0043).

As per claim 12, Vishwanath-Naim teaches the method of claim 4, wherein storing the certificate comprises: interfacing the token to a server computer; and writing the certificate to the token at the server computer (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 13, Vishwanath-Naim teaches the method of claim 5, wherein distributing data to the client comprises distributing a media player (Naim: column 8, lines 33-56).

As per claim 14, Vishwanath-Naim teaches a method for distributing data over a network comprising: establishing a secure connection between a client and a server (Vishwanath: 0702; Naim: column 8, lines 33-56; column 10, lines 44-49); receiving a request from the client for data to be downloaded (Vishwanath: 0702; Naim: column 8, lines 33-56; column 10, lines 44-49); generating a message associated with the data being downloaded to the client and associated with a portable token of the client and used by the client, the portable token being a physical device (Vishwanath: 0702; Naim: column 8, lines 33-56; column 10, lines 44-49); and distributing the data and the associated message to the client (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 15, Vishwanath-Naim teaches the method of claim 14, wherein establishing a secure connection comprises establishing a secure connection using a security protocol (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 16, Vishwanath-Naim teaches the method of claim 15, wherein the security protocol is the secure socket layer protocol (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 17, Vishwanath-Naim teaches the method of claim 14, wherein establishing a secure connection comprises requesting authentication information from the client; and sending authentication information from the server (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 18, Vishwanath-Naim teaches the method of claim 17, wherein requesting authentication information from the client comprises requesting a certificate from the client; and requesting a digital signature from the client (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 19, Vishwanath-Naim teaches the method of claim 17, wherein sending authentication information from the server comprises sending a certificate from the server; and sending a digital signature from the server (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 20, Vishwanath-Naim teaches the method of claim 18, wherein requesting a certificate comprises reading the certificate from the token used by the client (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 21, Vishwanath-Naim teaches the method of claim 14, wherein generating a message further comprises: including in the message a data identification number (Naim: column 8, lines 33-56; column 10, lines 44-49); including in the message a period of time for which the data may be used by the client (Vishwanath: 0105); and including in the message a symmetrical key used to encrypt the data from the server to the client over the network (Naim: column 8, lines 33-56; column 10, lines 44-49). Motivations to combine teachings are discussed in the treatment of claim 1.

As per claim 22, Vishwanath-Naim teaches the method of claim 14, wherein generating a message further comprises generating a message using a public key (asymmetric) cryptographic algorithm (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 23, Vishwanath-Naim teaches a method of securely utilizing downloaded data comprising: opening a media player (Naim: abstract); opening a data file (Naim: column 8, lines 33-56; column 10, lines 44-49); requesting a portable token from and used by a client, the portable token being a physical device (Naim: column 8, lines 1-30; Vishwanath: 0702); reading a distinguishing number from the token (Naim: column 8, lines 33-56; column 10, lines 44-49); verifying a digital message associated with the data file and the token using the media player, the distinguishing number, and a private key in the token (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 24, Vishwanath-Naim teaches the method of claim 23, wherein in verifying a digital message, the media player reads the private key from the token to decrypt the digital message Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 25, Vishwanath-Naim teaches the method of claim 23, wherein in verifying a digital message, the media player sends the digital message to the token (Naim: column 8, lines 33-56; column 10, lines 44-49).

As per claim 26, Vishwanath-Naim teaches the method of claim 25 and the use of a public key to decrypt an encrypted symmetric key, but does not specifically teach the token's decryption of an encrypted symmetric key using the private key. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the functionality of the use of a private key to decrypt an encrypted symmetric key, as it is well known in the art. (See: Fischer, U.S. 5,436,972; column 12, lines 36-45, for example). Also, the use of a private key to decrypt, over the use of a public key is a design choice, and is thus not patentably distinct.



As per claim 27, Vishwanath-Naim teaches the method of claim 23, wherein verifying a digital message comprises verifying the distinguishing number read from the token (Naim: column 8, lines 33-56; column 10, lines 44-49); verifying a time period associated with the data file (Vishwanath: 0105); decrypting an encrypted symmetrical key using the private key from the token; and decrypting the data file using the symmetrical key (see discussion of claim 26).

### *Response to Arguments*

Applicant's arguments filed on May 30, 2006 have fully been considered, and are respectfully traversed by the new grounds of rejection set forth above.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanim Hossain whose telephone number is 571/272-3881. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571/272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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